

REMARKS

Entry of the foregoing and reconsideration of the application identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.111 and in light of the remarks which follow, are respectfully requested.

By the above amendments, claim 23 has been amended for clarification purposes, and now recites "Modified stable non-foamed polyisocyanates." Claim 50 has also been amended for clarification purposes, and now recites "a modified stable non-foamed polyisocyanate." Support for the above amendments can be found in the instant specification at least at page 3, lines 26-33. Claim 23 has further been amended for clarification purposes, and now recites that the isocyanate functions are optionally masked. Support for such amendment can be found in the specification at least at page 15, lines 6-9. Claims 40, 43 and 45-49 have been amended for readability and/or clarification purposes.

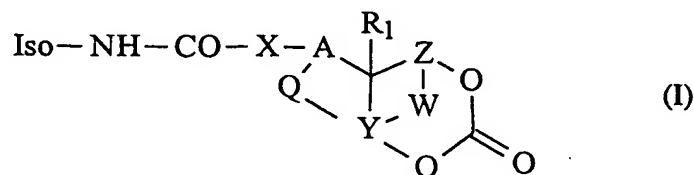
In the Official Action, claims 43, 44 and 47-49 stand rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth at pages 2 and 3 of the Official Action. Claims 48 and 49 stand rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth at page 3 of the Official Action. Without addressing the propriety of the above rejections, it is noted that the rejections are moot in light of the above amendments of claims 43, 48 and 49. Accordingly, withdrawal of the above rejections is respectfully requested.

Claims 23-35 and 37-59 stand rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth at pages 3-5 of the Official Action. Without addressing the propriety of such rejection, it is noted that the rejection is moot in light of the above amendments of claims 23, 40, 43, 46, 47 and 49. Accordingly, withdrawal of the above rejection is respectfully requested.

Claims 23-27, 30, 31, 33-35, 42, 45, 48, 50, 55, 56 and 59 stand rejected under 35 U.S.C. §102(b) as being anticipated by European Patent Document No. 0 419 114 (*EP '114*).

Withdrawal of this rejection is respectfully requested for at least the following reasons.

According to one aspect, independent claim 23 is directed to modified stable non-foamed polyisocyanates of formula 1 below having a crosslinking functional group:



in which:

- Iso is a polyisocyanate residue containing at least two isocyanate functions after conversion of at least one isocyanate function, wherein the isocyanate functions are optionally masked;
- X represents an atom or a group of atoms resulting from the reaction of a compound bearing a -XH group, optionally after decarboxylation, with an isocyanate function;
- A represents a bond or a linear, branched or cyclic hydrocarbon-based chain containing from 1 to 30 carbon atoms;
- R₁ represents H or a C₁-C₆ alkyl group;
- Q is absent or represents an oxygen or sulfur atom or a hydrocarbon-based chain as defined for A;
- Z represents a bond or a hydrocarbon-based chain as defined for A;
- Y represents a bond or a hydrocarbon-based chain as defined for A;

- W is absent or represents a bond, an oxygen or sulfur atom or a hydrocarbon-based chain as defined for A; and
 - Q being absent when Y or A represents a bond and W or A being absent when Y or Z represents a bond;
- with the proviso that Z and Y do not simultaneously represent a bond.

EP '114 relates to a method for the preparation of polymeric foams which comprises reacting an organic polyisocyanate with a cyclic carbonate having at least one isocyanate-reactive substituent attached to the carbonate ring, and is discussed at page 3 of the present specification (see abstract).

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.3d 1349, 1351 (Fed. Cir. 2001). In the present case, *EP '114* does not disclose each feature recited in independent claim 23, and as such fails to constitute an anticipation of such claim. For example, *EP '114* does not disclose modified stable non-foamed polyisocyanates of formula I, as is now recited in claim 23. In stark contrast, *EP '114* discloses a method for the preparation of polymeric foams which comprises reacting an organic polyisocyanate with a cyclic carbonate (page 2, lines 23-25). Quite clearly, *EP '114* discloses the preparation of polymeric foams, and fails to provide any disclosure or recognition of modified stable non-foamed polyisocyanates of formula I, as now recited in claim 23.

In view of the above, it is apparent that *EP '114* fails to constitute an anticipation of independent claim 23. Accordingly, for at least the above reasons, withdrawal of the above rejection is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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